

REMARKS

Claims 1-11, 13, 14, and 18-25 remain pending in this application. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Withdrawn Claims

Applicant acknowledges the withdrawal of claims 18-25. In accordance with MPEP §821.04, Applicant respectfully requests rejoinder of claims 18-25, which include all of the limitations of independent claim 1, upon the allowance of independent claim 1.

Claim Rejections-35 U.S.C. §102

Claims 1-11, 13, 14, and 18 stand rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 6,529,775 issued to Whitebrook, et al. ("Whitebrook"). Applicant respectfully traverses this rejection, since Whitebrook does not disclose each and every element required by these claims.

While Applicant is fully aware that an "intended use" limitation has no patentable weight, the combination of the "ablation" limitations recited in independent claim 1 are not an intended use, but rather a combination of functional limitations that none of the Whitebrook devices is capable of performing, and thus must be given patentable weight.

The Patent Office has stated:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.

* * *

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. M.P.E.P. §2173.05(g).

It is not known whether the Examiner considers the emitter 412 (page 3 of the office action) or the electrode 402 (page 5 of the office action) as being the claimed ablative element or ground element, but in either case, claim 1 would not be expressly or inherently anticipated by Whitebrook.

In particular, assuming that the emitter 412 disclosed in Whitebrook can somehow be operated as a tissue ablation element, the protective elements 432-434 would at least partially cover the emitter 412—not the ground element (whatever other element the Examiner would consider the ground element), as required by claim 1. Assuming that the emitter 412 disclosed in Whitebrook can somehow be operated as a ground element, the protective elements 432-434 do at least partially cover the ground element, but there is no express or inherent disclosure of a separate ablative element to convey ablation energy to this ground element.

Assuming that the outer electrode 402 disclosed in Whitebrook can somehow be operated as a tissue ablation element, and the inner electrode 404 can somehow be operated as a ground element, any target tissue region in which the outer electrode 402 is in contact would likely not be ablated, since the ablation energy would mainly flow from the outer electrode 402 to the inner electrode 404. Even if some ablation occurs in the target tissue surrounding the outer electrode 402, claim 1 requires that the solid tissue adjacent the ground electrode not be ablated. The only solid tissue adjacent the inner electrode 404

is the same target tissue that would be ablated by the electrode 402—a result that is prohibited by claim 1. Assuming that the inner electrode 404 can instead be somehow operated as a tissue ablation electrode and the outer electrode 402 operated as a ground electrode (reverse of previous case), there is no protective element that at least partially covers the outer electrode 404 (as the ground electrode element).

As such, Applicant submits that independent claim 1, as well as the claims depending therefrom (claims 2-11, 13, 14, and 18), are not anticipated by Whitebrook, and as such, respectfully request withdrawal of the §102 rejections of these claims. If the Examiner maintains the rejection of claims 1-11, 13, 14, and 18, it is respectfully requested that the Examiner specifically delineate which combination of features disclosed in Whitebrook constitute the claimed ablative electrode element, ground electrode, and the functional language that interrelates and characterizes these structural elements.

Claim Rejections-35 U.S.C. §103

Claims 6, 11, 16, and 17 stand rejected under 35 U.S.C. §103, as being obvious over Whitebrook. Applicant respectfully traverses this rejection, since Whitebrook does not disclose, teach, or suggest the combination of elements required by these claims. In particular, as previously discussed, Whitebrook does not disclose all of the elements required by independent claim 1 from which these claims depend.

Thus, Applicant submits that claims 6, 11, 16, and 17 are not obvious over the Whitebrook, and as such, respectfully request withdrawal of the §103 rejection of these claims.

Conclusion

Based on the foregoing, it is believed that all claims are allowable, and thus, a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (949) 724-1849.

Respectfully submitted,

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